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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,813	07/12/2001	Scott I. Klein	P24448-D US1	1787

7590 10/21/2003

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,813

Applicant(s)

KLEIN ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Pursuant to the directives of paper No. 13 (filed 7/21/03) claim 21 has been amended.

Claims 20-21 remain pending.

Applicants arguments filed 7/21/03 have been considered and found not persuasive.

*

Claim 21 is rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, fifth line from last, the following is recited: "p is 1 or 2". In claim 21, second-to-last line, the following is recited: "P is 1 or 4". First, there is a conflict between the two definitions, and second, there is no variable "P" (in the structural formula) in which the "P" is uppercase.

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. §102(b) as being anticipated by Klinger (USP 5,399,570).

As indicated previously, Klinger discloses (col 13, line 58) the following compound:



This corresponds to the substituent variables (of claim 20) as follows:

F' = hydrogen;
G = substituted aralkyl;
B = methyl;
X = hydrogen

In the response filed 7/21/03, it is argued that a 2,2-diphenylethyl group does not fall within the scope of the term "substituted aralkyl". It is also argued that the term at issue does not fall within the scope of the term "aralkyl" wherein the term "aralkyl" is not qualified as being further substituted. Whatever the merits of this latter argument, it is unpersuasive, since claim 20 permits G to be substituted aralkyl, and it is to this embodiment that this ground of rejection is directed. As to the question of whether a 2,2-diphenylethyl group falls within the scope of the term "substituted aralkyl", it is maintained that the 2,2-diphenylethyl group does qualify. Certainly, a phenethyl group *per se* is an aralkyl group; when substitution of this group with a phenyl group occurs, the result is a 2,2-diphenylethyl group. The term "substituted aralkyl" means that one begins with an aralkyl group, and then substitutes one of the hydrogen atoms with another substituent. Certainly, the 2,2-diphenylethyl group meets this test. The response filed 7/21/03 also asserts, without evidence or explanation, that when the term "substituted" is used, it can only be applied to

an aryl group or to a cycloalkyl group. The logic of such a notion is unclear. There is no prohibition recognized in the field of organic chemistry against substituting an alkyl group with another moiety. Claim 20 recites that it is the aralkyl group that is substituted; claim 20 does not specify that when the aralkyl group is to be substituted that substitutions on the alkyl portion are excluded.

Next, it is argued that the compound of Klinger is not specifically disclosed in the instant application; however, the claim nevertheless encompasses it.

Next, it is argued that Klinger does not explain how to synthesize the compound that is the basis of this rejection. However, the claims are not drawn to a method of making compounds, but to compounds *per se*. Accordingly, the method of synthesizing the compound is not at issue. It is also argued that the fact that the compound of Klinger is merely a synthetic intermediate, rather than an "end product" supports applicants' assertion that the reference is not anticipatory. However, this is an "intended use" argument. The intended use of a compound disclosed in a reference does not have to be the same as that asserted by an applicant in order for the rejection to be proper. It is also asserted that the designation used by Klinger is confusing; the following is also stated:

"the fact that the combination would occur at the location which can therefore be reasonably interpreted as a reactive hydrazine"

What exactly this phrase is intended to mean is unclear. However, the response filed 1/7/03 attempted to argue that one could infer that the compound Sar-Asp(OBz)-3,3-

diphenylpropylamide is really a hydrazine. However, the compound Sar-Asp(OBz)-3,3-diphenylpropylamide is not a hydrazine. This matter was discussed at some length in the Office action mailed 3/20/03. The arguments presented therein are incorporated herein by reference.

It remains the case that the compound disclosed by Klinger is encompassed by claim 20; the rejection is maintained.

*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

D. Lukton 10/20/03

Christopher S. F. Low
CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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